UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,389	04/20/2001	Daniel C. Castle	10006967-1	2509

7590 09/23/2005	EXAMINER
HEWLETT-PACKARD COMPANY	LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

DATE MAILED: 09/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 July 2005</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-22 have been examined. Application 09/839,389 (BACKGROUND

ADVERTISING IN AN INTERNET ENVIRONMENT) has a filing date 04/20/2001.

Response to Amendment

2.   In response to Final Rejection filed 04/06/2005, the Applicant filed an RCE on

07/06/2005, which amended claims 1, 6, 12, 17 and 20.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-9, 12 and 14-16 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Rashkovskiy (US 6,616,533) in view of Angles (US 5,933,811).

As per claims 1, 6 and 12, Rashkovskiy teaches:

A method for displaying advertisements over the Internet to a computer device

comprising the steps of:

displaying on the computer device informational content on a first layer (see

figure 8, item 122);

determining advertising content related to the information content (see

Rashkovskiy see abstract "once the game play is paused, an advertising graphical user

interface may be displayed that enables the user to purchase items associated with

image elements observed in the course of game play");

displaying on the computer device *muted* advertisement content behind the informational content, on a second layer, (see <u>Rashkovskiy</u> figure 8, items 112, 116, 118, 120, 114) such that both the informational content (i.e. information of playing the game, such as moving cars) and the advertisement content are viewable simultaneously (see <u>Rashkovskiy</u> figure 8), and

displaying on the computer device non-transparent hyper-linked advertisement content on the first layer that is related to the advertisement content on the second layer (see <u>Rashkovskiy</u> column 5, lines 10-20; figure 8, items 112-120 are clickable background images) but fails to teach *wherein the advertising content is updated when changes occur to a profile of an Internet consumer.* However, <u>Angles</u> teaches in column 15, lines 20-31 "The advertising module 62 uses the consumer member code 22 to obtain a consumer profile from the registration database 68. As discussed in more detail below, the advertising module 62 then uses the consumer profile to select an appropriate advertisement from the advertisement database 70. In another embodiment, the advertising module 62 uses both the consumer profile and the content provider information to select an appropriate advertisement from the advertisement database 70. The advertising module 62 then sends a customized advertisement 30 directly to the consumer computer 12 to be incorporated into an electronic page 32 from the content provider computer 14". Also, <u>Angles</u> teaches in column 21, line 53 – column 22, line 65 "The embodiment shown in FIG. 9 allows the customized advertisements 30 to be incorporated directly into the content provider's offerings. Thus, in addition to integrating the customized advertisements 30 in to an electronic page 32, the content

provider computer 14 can integrate the customized advertisements 30 into offerings such as **on-line games**, video programming, internet radio, virtual reality environments and the like. For example, assuming the content provider computer 14 offers consumers **on-line games** such as interactive car races. In this example, the content provider computer 14 can integrate the customized advertisements 30 into signs and billboards which appear in the interactive game. In other embodiments, the content provider computer 14 can integrate the customized advertisements 30 into three dimensional worlds defined by the Virtual Reality Modeling Language (VRML 1.0). VRML 1.0 is a draft specification for the design and implementation of a platform independent language for virtual reality scene description. VRML 1.0 was released on May 26, 1995. For instance, the content provider computer 14 may display a three-dimensional mall, shopping center or city, which displays customized advertisements 30 on virtual reality posters and billboards. Rashkovskiy teaches in column 3, lines 35-50 "In some embodiments of the present invention, a connection to a network such as the Internet may be utilized to update the advertising. Additional advertising may be provided for additional hot clickable elements. Moreover, the advertising subject matter may be modified. Particularly, in connection with advertising associated with background material, the sponsoring advertising may be modified by downloading new software periodically. Thus, in one embodiment of the present invention, a sponsor may sponsor a background image in the course of the game and after a period of time may no longer continue that sponsorship. A new sponsor may assume the position previously occupied by the previous sponsor. At such time, new software may be downloaded to change the

background material". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rashkovskiy would display background advertisements in online games (see Rashkovskiy figure 8, item 114) and where said advertisements would be customized and updated based upon a user's profile, as taught by Angles. Rashkovskiy would be motivated to target advertisements displayed in the background of an online game using a user's profile for said targeting in order to display advertisements to a user more likely to use the product or offer being offered by said advertisements. Rashkovskiy would also be motivated to incorporate said advertisements in the background of on-line game in order to associate said advertisements with entertainment (i.e. playing a fun game) and therefore, increasing the probability that said advertisements would be viewed and click by a user of said game.

As per claim 2, Rashkovskiy teaches:

The method of claim 1 and further including the step of displaying both the first and the second layers on a monitor device such that both layers are viewable simultaneously (see figure 8; column 5, lines 10-20).

As per claims 3, 4 and 8, Rashkovskiy teaches:

The method of claim 1 but fails to teach and further including the step of printing both the first and the second layers on a page such that both layers are viewable simultaneously and printing the first and second layers. However, Official notice is taken that it is old and well known in the computer art to print a image that is displayed in the active area of a computer screen. It would have been obvious to a person of ordinary

skill in the art at the time of applicant's invention was made to know that a image consisting of a content with a background advertisement that is displayed in a computer screen would be printed using a computer printer.

As per claim 5, , Rashkovskiy teaches:

The method of claim 1 wherein the advertisement content on the first layer, and the advertisement content on the second layer are related by a common product or service (see figure 8, items 112-120).

As per claim 7, Rashkovskiy teaches:

The method of claim 6 and further including the step of the client process requesting delivery of the first and second layers (see column 2, lines 1-20).

As per claim 9, Rashkovskiy teaches:

The method of claim 7 wherein the client process is resident on a personal computer comprising a monitor device (see column 2, lines 20-35).

As per claim 14, Rashkovskiy teaches:

The system of claim 12 wherein the storage media stores information relating to the client process (see column 2, lines 7-50).

As per claim 15, Rashkovskiy teaches:

The system of claim 14 wherein the processor has means for determining an advertisement content from the plurality of advertisement content in response to the information relating to the client process (see column 3, lines 35-50).

As per claim 16, Rashkovskiy teaches:

The system of claim 12 wherein the client process is an automatic content delivery service that requests information content from predetermined Internet resources (see column 3, lines 35-50).

Claims 10, 11, 13 and 17-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rashkovskiy (U.S. 6,616,533) in view of Angles (US 5,933,811) and further in view of Anderson (U.S. 6,532,039).

As per claim 10, Rashkovskiy teaches:

The method of claim 7 but fails to teach and further including the step of the client process requesting a predetermined level of transparency of the second layer. Anderson teaches a system that allows to specify the level of transparency of a background image (see column 8, line 50- column 9, line 27). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rashkovskiy would adjust the level of transparency of a background advertisement, as taught by Anderson. Adjusting the level of transparency would allow to adjust the contrast between the content image and the background image displayed in the computer screen so both images can be viewed simultaneously.

As per claims 11, 13, 17, 19, 20, 21 and 22, Rashkovskiy teaches:

determining advertising content related to the informational content (see Rashkovskiy see abstract "once the game play is paused, an advertising graphical user interface may be displayed that enables the user to purchase items associated with image elements observed in the course of game play"), but fails to teach *wherein the*

advertising content is updated when changes occur to a profile of an Internet consumer. However, the same argument made to claim 1 is made to claim 20.;

combining the advertisement content with the predetermined information content to form a Web page *so the transparent advertising content is muted* (see <u>Rashkovskiy</u> figure 8, items 112, 116, 118, 120, 114), displaying non-transparent hyper-linked advertisement content that is related to the transparent advertisement content (see <u>Rashkovskiy</u> figure 8, column 5, lines 10-20) but fails to teach and further including the step of the transparency of the advertisement content being adjusted to the predetermined level in response to a composition of the computer device and that first layer and the second layer can be viewed simultaneously. However, <u>Anderson</u> teaches the image display would be adjusted depending upon the display interface (see column 8, lines 42-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Rashkovskiy would adjust the level of transparency of a background advertisement depending upon the display interface, as taught by Anderson. This feature would allow that the background image and the foreground image can be viewed simultaneously independently of the type of display.

As per claim 18, <u>Rashkovskiy</u> teaches:

The method of claim 17 wherein the request for predetermined information content is transmitted by the client process (see Rashkovskiy column 10, lines 1-26).

Response to Arguments

4.   Applicant's arguments filed 07/06/2005 have been fully considered but they are not persuasive. The Applicant argues that Rashkovskiy does not teach an advertising content related to the information content. The Examiner answers that Rashkovskiy teaches in the abstract "once the game play is paused, an advertising graphical user interface may be displayed that enables the user to purchase items associated with image elements observed in the course of game play" and also column 5, lines 7-10 "A wide variety of items may be sold using the hot clickable image elements. For example, clothing and action figures or dolls associated with the image elements may be offered in this fashion". Therefore, the Rashkovskiy's background advertisements are related to the information content (i.e. online game), similar to the Applicant's claimed invention.

With respect to Applicant's argument that the reference teaches away from the Applicant's claimed invention. The Examiner answers that *In re Susi,* 169 USPQ 423 (CCPA 1971) Disclosed examples and preferred embodiments **do not constitute a teaching away** from a broader disclosure or non-preferred embodiments.

The Applicant argues that and that Rashkovskiy does not teach that the advertisement content is muted. The Examiner answers that the Applicant only mentions the word "muted" in the Applicant's specification page 4, line13, which discloses "the advertisement layer is muted". However, Applicant does not define what "muted" means. Therefore, the Examiner obtains the definition of "muted" as "subdued; softened: *muted colors"* (see dictionary.com). Therefore, Rashkovskiy teaches advertisements that are muted or subdue to a first layer content (i.e. online game), so

said advertisements appears as background advertisements to said first content (i.e. online game), similar to the Applicant's claimed invention.

Applicant's arguments with respect to "wherein the advertising content is updated when changes occur to a profile of an Internet consumer" have been considered but are moot in view of the new ground(s) of rejection.
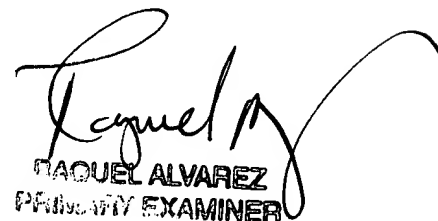
Conclusion

5.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
September 15, 2005

RAQUEL ALVAREZ
PRIMARY EXAMINER